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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,720	08/17/2006	Tatsuya Suetsugu	VX062750 PCT	9513

23400 7590 08/29/2008  
POSZ LAW GROUP, PLC  
12040 SOUTH LAKES DRIVE  
SUITE 101  
RESTON, VA 20191

EXAMINER
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PETKOVSEK, DANIEL

ART UNIT	PAPER NUMBER
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2874

MAIL DATE	DELIVERY MODE
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08/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/589,720	<b>Applicant(s)</b> SUETSUGU ET AL.	
	<b>Examiner</b> DANIEL PETKOVSEK	<b>Art Unit</b> 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on pre-amd filed August 17, 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 17, 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/31/06; 8/17/06</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is in response to the application including a preliminary amendment filed August 17, 2006. In accordance with the preliminary amendment, claim 3 has been amended while new claims 6-8 have been added.

Claims 1-8 are pending.

#### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on February 20, 2004. It is noted, however, that the PTO has not received a certified copy of the JP 2004-044734 application as required by 35 U.S.C. 119(b).

2. This application is a 371 of PCT/JP2005/002246, filed February 15, 2005. It is noted that the certified copies of the priority documents have not been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). Applicant is requested to provide a copy of these documents in response to this office action.

#### ***Information Disclosure Statement***

3. The prior art documents submitted by Applicant in the Information Disclosure Statements filed on August 17, 2006 and October 31, 2006, have been considered and made of record (note attached copy of forms PTO-1449).

#### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: the sequence of claim 1 in which "and thallium compounds, an organic resin, and an organic solvent" should read, "and thallium compounds; an organic resin; and an organic solvent" with

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semi-colons (rather than a comma) to properly distinguish each component of the paste. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Besselink U.S.P. No. 3,997,312.

Besselink U.S.P. No. 3,997,312 teaches (ABS; Table column 1, lines 55-60; Table column 2, lines 7-15; claims) a method of producing an optical element comprising applying a paste containing at least one compound selected from lithium, potassium, rubidium, cesium, *silver* (see Table), and thallium; an organic resin ("solution of 1.5kg of camphor in 2.5 l of xylene" is an organic resin composition); and an organic solvent (acetone) to a glass substrate containing an alkali metal component (see Table included in claim 1) as a glass component and then performing heat treatment at a temperature below the softening temperature of the glass substrate (since structure is maintained), which clearly, fully meets Applicant's *claimed* limitations for sole independent method claim 1.

Regarding claim 2, the glass substrate is made of a glass containing at least 2% by weight of alkali metal, calculated on an oxide basis, the glass being silicate glass, *borosilicate* glass (14.9%), phosphate glass, or fluorophosphate glass.

Regarding claims 3 and 6, the method (claims 1 and 2 above) of Besselink '312 produces an optical element.

Regarding claims 4 and 7, the optical element of Besselink '312 is at least an optical waveguide, since optical signals are capable of being transmitted therein.

Regarding claims 5 and 8, the optical element of Besselink '312 is at least in the form of a slab waveguide, since optical signals are capable of being transmitted therein and in a slab type form in the substrate.

### ***Inventorship***

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: PTO-892 form references A-C.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL PETKOVSEK whose telephone number is (571)272-4174. The examiner can normally be reached on M-F 8:30-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel Petkovsek/  
Patent Examiner, Art Unit 2874  
August 27, 2008